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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,214	05/08/2001	Guido Voit	48839DIV	4235

26474 7590 06/05/2002

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1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

SACKEY, EBENEZER O

ART UNIT	1	PAPER NUMBER
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1626

DATE MAILED: 06/05/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/851,214

Applicant(s)
VOIT ET AL.

Examiner
EBENEZER SACKKEY

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1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 12, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/622,773.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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DETAILED ACTION

This is a response to applicants Information Disclosure Statement and amendment B filed on 3/12/02 and 3/14/02 respectively. The I.D.S. has been considered and made of record. Applicants have amended claims 21-25 by changing "mixtures" to ---mixture thereof-- and "obtainable" to ---which is obtained--- to overcome the 112, second paragraph rejection. Therefore, the 112-second paragraph rejection has been withdrawn.

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a

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background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 21-25 and new claims 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dewdney (I) or (II) and Flick et al. for the reasons set forth in paper number 3.

Response to Amendment

Applicant's arguments filed 3/14/02 have been fully considered but they are not persuasive. Applicants argue that the instant invention, i.e., the hydrogenation catalyst in addition to iron or iron compound, comprises components (a) to (d) in the ratios stipulated. This argument is unpersuasive because Dewdney (I) or (II) and Flick et al. suggest similar results of a hydrogenation catalyst with similar ratios of components (a) to (d) for the production of nitriles. Applicants next argue that neither of Dewdney (I) or (II) suggests the addition of manganese to the catalyst composition. This is unpersuasive because applicants' claims recite a hydrogenation catalyst which

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comprises components (a) to (d). "Comprising" is an opened-ended word. It permits the inclusion of unrecited elements.

Applicants argue next that Flick et al catalyst composition is based on either cobalt oxide or nickel oxide as component (a) which is vastly different from the instant composition. This is not persuasive because the disclosure on column 2, lines 28-45 teach the combinations of the elements with or without iron. Applicants next argue that Flick's reference teaches an attempt to reduce the formation of hexamethylenediamine in the partial hydrogenation of adiponitrile to improve the formation of aminocapronitrile. This is also unpersuasive because the disclosure did not show that hexamethylenediamine is not produced. Nothing unobvious is seen with this process. Accordingly, one of ordinary skill in the art would be motivated to manipulate process parameters (as is done in instant claims 21, 26 and 29-32) of the basic process of the references in order to improve yield and selectivity as taught. Furthermore, applicants have not provided any specific unexpected results. Applicants should note that unexpected results must be established by factual evidence, mere arguments will not suffice. Additionally, "unexpected results must be established by comparing the claimed invention against the closest prior art."

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (703) 305-6889. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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EOS

May 28, 2002

Joseph K. McKane

Supervisory Patent Examiner

Art Unit 1626, Group 1600

Technology Center 1

Alan L. Rotman

ALAN L. ROTMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

for Joseph K. McKane